

### **ATTACHMENTS**

Attached hereto is a terminal disclaimer over claims 1-9 of U.S. Patent 6,572,305. In light of this terminal disclaimer and the abandonment of co-pending Application No. 10/453,366, it is now believed that rejections with respect to double patenting have been overcome.

### **REMARKS**

This amendment is submitted to be fully responsive to the well-reasoned Office Action of Paper No. 20040220. Reconsideration of the objections and rejections is requested in light of the above amendments and the following remarks.

The specification has been objected to for the informality with regard to the typographical error regarding the Heenan patent found at page 7, line 20. By way of this amendment this error has been corrected. Additionally, the abstract is objected to because of the word "said" being present. Accordingly, Applicant has amended the abstract to substitute the word "the" for "said." Claims 5, 6, 7, 17, 18, 24 and 25 are objected to because of various informalities. Claim 7 is confusing with respect to a reflective end piece and how that relates to the reflective portion of base claim 1. A question as to the dependency of the other rejected claims has also been raised. In response to these objections, claim 7 has been amended to clarify the integral nature of the shell. With respect to claims 5, 6, 17, 18, 20 and 23, the dependency has been reviewed to consistently depend from the base independent claim. With these claim amendments it is believed that the outstanding claim objections have been overcome.

**Remarks Directed to Rejection of Claims 1-25 under  
35 U.S.C. §103(a) Over Heenan (U.S. Patent 3,332,327) in View of  
Coderre et al. (U.S. Patent 6,325, 515) and Admitted Prior Art**

Heenan is cited for disclosing a basic marker, yet is silent as to the shell being formed of the specific polymers called for in claims 1-6, 13-18 and 20-25. (Paper No. 20040220, page 3, last full paragraph). Coderre et al. is cited to bolster the teaching of Heenan with respect to a bond coating over the reflective coating where the bond coating is a bonding primer as detailed at column 3 beginning at line 56. (Paper No. 20040220, page 3, last full paragraph). Lastly, the rejection relies on Applicant's identification of a commercially available polymer (Plexiglas V052) as exemplary of a material satisfying the claim limitations. The basis of the resulting rejection is that it would be obvious to one skilled in the art "to cover the reflective coating in order to protective the reflective coating from corrosion thus lengthening the life of the reflective marker and to have the shell sustain specified impact as well as have a specific transparency depending on its desired use." (Paper No. 20040220, page 3-4, bridging paragraph). The Examiner also relies on U.S. Patents 4,234,265 and 4,498,733 for evidence that it is known to use Plexiglas as a roadway reflector shell.

The pending independent claims, claims 1, 13 and 20, all include the limitation that the shell is formed of either polyacrylate or polycarbonate having "a tensile strength of greater than 9,000 pounds per square inch and a ratio of tensile strength to flexural modulus of between 0.021-0.050 : 1."

Applicant readily concedes that polyacrylate has been used in the prior art to form reflective pavement marker shells. By extension, Applicant concedes there is a large number of commercially available polyacrylate materials and polycarbonate materials that are commercially available or are readily synthesized.

Applicant submits that the present invention lies not in identifying polyacrylate or polycarbonate for this application, but rather identifying the minimal tensile strength and the ratio of tensile strength to flexural modulus in order to balance the properties of a reflective pavement marker to best endure the forces experienced in a road environment. Identification of tensile strength and the ratio of tensile strength to flexural modulus represents a small subset of all the possible polyacrylate and polycarbonate polymers available.

The courts have stated that an invention is nonobvious even though the endeavor was obvious to try when:

in some cases, what would have been “obvious to try” would have been to vary all parameters or try each of the numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful.

*In re O’Farrell*, 853 F.2d 834, 7 USPQ2d 1273 (Fed. Cir. 1988) citing for example *In re Geiger*, 2 USPQ2d at 1278; *Novo Industry A/S v. Travanol Laboratories*, 215 USPQ 412, 417; *In re Yates*, 211 USPQ 1149; and *In re Anthony*, 195 USPQ 8.

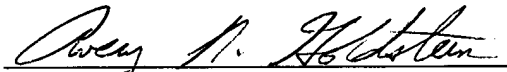
Applicant submits that of the nearly infinite grades of polyacrylate and polycarbonate available one skilled in the art could certainly vary all possible parameters and try each of the various polymers until a successful result had been arrived at. However, Applicant submits that the prior art lacks guidance as to the choice of material parameters which are critical from the many available. The claims of the present invention result from the discovery that tensile strength and its relationship to flexural modulus within the proscribed range affords the compromise in material properties that ultimately yields optimal longevity on a roadway surface environment.

In light of the above remarks, it is now believed that the obviousness rejection as to pending claims 1-25 under 35 U.S.C. §103(a) has been overcome. Reconsideration and withdrawal of this rejection is requested.

**Summary**

Claims 1-25 are pending in this application. This amendment is believed to address all outstanding objections and rejections. With the entry of this amendment, all the pending claims are believed to be directed to allowable and patentable subject matter. Allowance of these claims and the passing of this application to issuance are solicited. Should the Examiner find to the contrary, it is respectfully requested that the undersigned attorney in charge of this application be contacted.

Respectfully submitted,



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Enclosure